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Mailed: February 25, 2003  
Paper No. 8  
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brainybrawn.com, Inc.

Serial No. 76/166,184

Myron Amer of Myron Amer. P.C. for Brainybrawn.com, Inc.

Tracy L. Fletcher, Trademark Examining Attorney, Law Office  
115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Seeherman and Bottorff, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Brainybrawn.com, Inc. has applied to register  
HEALTHLYNX for "arranging for providing health care  
services, namely, dental services, vision services,  
chiropractic, acupuncture, massage therapy, hearing  
services and non-medical elderly home care."<sup>1</sup> The Examining

<sup>1</sup> Application Serial No. 76/166,184, filed November 16, 2000,  
and asserting first use and first use in commerce on October 1,  
2000. In its appeal brief and reply brief applicant has been  
identified as Healthlynx.com, Inc., but applicant has not made

Attorney has refused registration, making final the requirements for an acceptable identification of services, specimens and samples of advertisements or promotional materials. In particular, the Examining Attorney has stated that the identification of services is indefinite, and that the specimens do not evidence use of the mark for the identified services.<sup>2</sup> Registration has also been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the following registered marks<sup>3</sup> that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive:

**Health  
Link**

(stylized form),  
with the word HEALTH disclaimed,<sup>4</sup>

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any mention nor submitted any evidence of an assignment of the application or a change of name of the applicant. Accordingly, we will continue to identify applicant as Brainybrawn.com, Inc.

<sup>2</sup> The Examining Attorney indicated some identifications as examples of language that would generally be acceptable, including, based on the specimen of record, "promoting health care services of others through the distribution of discount cards," but stated that such an identification would be beyond the scope of the identification of services as stated in the original application, and therefore the identification could not be so amended. See Trademark Rule 2.71(a).

<sup>3</sup> Registration was also refused based on Registration No. 1,676,967, issued February 25, 1992, but this registration has since expired.

<sup>4</sup> Registration No. 2,194,562.

and HEALTH LINK, with the word HEALTH disclaimed,<sup>5</sup> both for "managed health care services, namely, for health maintenance organizations and preferred provider organizations"; and



(heart design)<sup>6</sup>  
for "health care in the nature of a preferred provider organization (PPO), and an health maintenance organization (HMO).

The first two registrations are owned by North Mississippi Health Services, Inc., and were published subject to a concurrent use proceeding with the third registration.<sup>7</sup> Rights in these registrations were limited to the state of Mississippi and certain counties in Alabama and Tennessee.

The appeal has been fully briefed, but applicant did not request an oral hearing.

We turn first to certain procedural points. At page 8 of its appeal brief applicant has indicated that it would adopt the identification "promoting health care services of

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<sup>5</sup> Registration No. 2,244,115

<sup>6</sup> Registration No. 2,058,527.

<sup>7</sup> The applications were also published subject to a concurrent use proceeding with Registration No. 1,676,967, which has since expired, and application No. 75/035,789, which was abandoned.

others through the distribution of discount cards" (Class 35) on condition that the specimen of use on record would be deemed acceptable. We do not regard this comment as an amendment of the identification. In any event, if applicant had wished to amend its identification, the proper procedure would have been to request that the application be remanded in order to have the Examining Attorney consider the proposed amendment. Further, in this case such a remand would have been futile, in view of the Examining Attorney's comment in the final Office action that he could not suggest that applicant so amend the identification because it would exceed the scope of the original identification.

Applicant also made the following statement in its appeal brief, at pp. 8-9:

Having suggested the below, there would appear to be no dispute on the identifications as follows:

Medical health care services, namely, dental services, vision and hearing health care services, chiropractic services, acupuncture and massage therapy services; non-medical elderly home care services, namely, retirement home services. (International Class 42).

Applicant further stated in its brief that it should have the option of proceeding with an identification under

either of these classes, i.e., either the Class 35 or the Class 42 identification quoted above.

It is unclear whether applicant is alternatively attempting to amend its identification to that recited immediately above, since applicant has also stated, at p. 9, that:

If the examining attorney accepts the conditions for amending to International Class 35 it would be applicant's preference to choose this classification, but if the conditions are not acceptable to the examining attorney and also are not acceptable to the Board, then it is respectfully requested that the application proceed to publication with the identification recited in the application as filed.

Again, applicant is advised that the proper procedure, if it wished to amend its identification, would have been to file a request for remand. Because no such request was filed, we will decide the appeal based on the identification as it currently appears in the application, namely, "arranging for providing health care services, namely, dental services, vision services, chiropractic, acupuncture, massage therapy, hearing services and non-medical elderly home care."

Applicant has also submitted with its appeal brief a new specimen.<sup>8</sup> The Examining Attorney has objected to this submission as untimely. We agree. See Trademark 2.142(d). Again, if applicant had wished to have the Examining Attorney consider a new specimen, the proper procedure would have been to request that the Board remand the application to the Examining Attorney.<sup>9</sup>

This brings us to the requirements and refusals that were the subject of the final Office action. We turn first to the requirement for an acceptable identification of services. The Examining Attorney has objected to the present identification on the basis that it is indefinite. Trademark Rule 2.32(a)(6) requires that the application include a list "of the particular goods or services on or in connection with which the applicant uses or intends to

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<sup>8</sup> This specimen appears to be a two-sided brochure which has been folded to create four pages. However, it appears that a section, i.e., one fold or two pages, has been removed from the brochure.

<sup>9</sup> Occasionally an applicant will attempt to comply with a requirement by, for example, offering an amendment to the identification of goods with its brief. If the Examining Attorney, in his brief, accepts the amendment, etc., or does not address the requirement, the Board will deem the requirement to be satisfied. See **In re Broyhill Furniture Industries Inc.**, 60 USPQ2d 1511, n. 2 (TTAB 2001). However, in this case, not only did the Examining Attorney object to the untimely submission of the specimen, but she also pointed out that the specimen was unacceptable because it was not accompanied by a declaration stating that it was in use as of the filing date of the application.

use the mark." As the Examining Attorney has pointed out, applicant's identification is broad enough to cover such services as "medical referrals for dental services, vision services, chiropractic, acupuncture, massage therapy, hearing services and non-medical elderly home care" in Class 35 and "health care services, namely dental services, vision services, chiropractic, acupuncture, massage therapy and hearing services" in Class 44. Because the identification could include services in more than one class, and because it is not clear from the identification "arranging for providing health care services" what applicant's service actually entails, applicant's identification is not sufficiently definite, and the requirement for an acceptable identification is affirmed.

Although we have found the identification of services to be unacceptable, we must consider this identification as we determine the propriety of the other requirements and refusals. The next requirement we will address is that for an acceptable specimen of use. In the first Office action, the Examining Attorney objected to the specimen because it appeared to be a color proof for a future brochure, and because it did not evidence use of the mark for the identified services. Responding to this Office action, applicant explained that the specimen which had been

submitted is a facsimile of an advertisement used "as stated in the application" [the application says "The mark is used in advertising and promotional materials, and one (1) specimen showing the mark as actually used is presented herewith"]. Applicant further stated that, because of its size, this advertisement was copied on two sheets, that only the sheet which bore the mark was originally submitted, and with this response applicant submitted the second page of the advertisement. In the final Office action, in which the requirement for an acceptable specimen was repeated, the Examining Attorney again objected to the specimen "because it does not show use of the mark in connection with the services identified in the application." The Examining Attorney made no mention, in this action, of any objection to the specimen on the basis that it was not an actual advertisement, but only a proof. However, in her appeal brief it appears that the Examining Attorney has renewed her objection to the specimen on the basis that it is merely a printer's proof.

Because the Examining Attorney did not, in the final refusal, object to the specimen on the basis that it was a printer's proof, thereby indicating to the applicant that this objection had been withdrawn, we think it unfair for her to raise it now. Accordingly, we will consider the



objection to the specimen only with respect to whether the specimen shows use of the mark in connection with the identified services.

The specimen, which appears to be a color photocopy of a brochure,<sup>10</sup> bears the mark HEALTHLYNX, with a design element, on what would be two different folds of the brochure. The rest of the brochure discusses "The Access Card," and explains that "The Access Card provides substantial discounts for services and products your present health plan may not cover." Additional copy states the "We have arranged for guaranteed discounts with thousands of providers throughout the nation for" and then goes on to list the areas of healthcare, including:

Prescription Drugs significant savings  
from retail at over 40,000 chain and  
independent pharmacies

Dental Services 20-40% savings at  
thousands of dentists

Vision Services 20-40% savings  
throughout the nation

Chiropractic Acupuncture & Massage  
Therapy significant savings at our  
credentialed national network

Hearing Services major savings  
throughout our nationals [sic] network

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<sup>10</sup> The copy has certain typographical errors circled, so it may indeed be a printer's proof.

The brochure goes on to provide more details about the benefits, e.g., "Hearing Services We have contracted with the largest independent audiology network in the United States. Members can receive a free consultation and discounts of 10%-20% on hearing aids and related supplies at our network of over 3000 licensed dispensing audiologists."

Because applicant's services are so broadly identified, we find that this specimen does show use of the mark HEALTHLYNX for "arranging for providing health care services, namely, dental services, vision services, chiropractic, acupuncture, massage therapy, hearing services and non-medical elderly home care." Specifically, the specimens indicate that applicant has arranged for discounts on medical and dental care with "thousands of providers." These activities would fall under the general category of "arranging for providing health care services...."

The third requirement which the Examining Attorney made final was for information clarifying the nature of applicant's services. The Examining Attorney required applicant to "submit samples of advertisements or promotional materials" and "if such materials are not available, the applicant must describe the nature, purpose

and channels of trade for the services." In response to the initial request for such information, applicant submitted "the ink original instructions provided by the applicant which forwarded the two-page document and indicated the first use thereof on 10/1/00." The two-page document refers to an additional copy of the specimen. The ink instructions are merely the responses on applicant's attorney's form which lists the information necessary to prepare a trademark application. Applicant responded to a question as to how the mark is being used by stating "as per the logo attached. [sic] on all marketing material." In addition, applicant responded to a request to list all goods and services identified by the mark with the following information: HEALTHLYNX ACCESS CARD-(DISCOUNT CARD) Provides consumers discounts on medical services (Dental, Vision, Pharmacy, Alternate Medicine etc.)."

This was the only information provided by applicant, and in the second and final Office action the Examining Attorney explained that it was insufficient to make clear the nature of applicant's services. Applicant did not address this requirement in its brief; in fact, applicant did not even indicate that this was one of the requirements in its listing of the issues on appeal, nor did it mention this requirement in its reply brief, although the Examining

Attorney devoted a section of her appeal brief (pages 15-16) to applicant's failure to satisfy the requirement.

Trademark Rule 2.61(b) provides that "The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." In response to such a request, an applicant has several options. As the Board stated in **In re SPX Corp.**, 63 USPQ2d 1592, 1597 (TTAB 2002):

It may comply with the request by submitting the required advertising or promotional material. Or it may explain that it has no such material, but may submit material of its competitors for similar goods or provide information regarding the goods on which it uses or intends to use the mark. Or it may even dispute the legitimacy of the request, for example, if the goods identified in the application are such ordinary consumer items that a request for information concerning them would be considered unnecessary and burdensome. What an applicant cannot do, however, is to ignore a request made pursuant to Trademark 2.61(b)....

Applicant's response to the requirement for additional information was, to say the least, minimal. However, we cannot say that applicant totally ignored the request. Further, although applicant did not clearly explain the nature of its services in its response to the Office action, the specimens and other materials submitted by

applicant do provide sufficient information such that we believe the requirement for further clarification was not necessary.

This brings us to the substantive basis for refusal, namely, that applicant's mark as used on its identified services is likely to cause confusion with the marks HEALTH LINK and HEALTH LINK (stylized) registered by North Mississippi Health Services, Inc. for "managed health care services, namely, for health maintenance organizations and preferred provider organizations" and the mark HealthLink with a heart design owned by HealthLink, Inc. for "health care in the nature of a preferred provider organization (PPO), and an [sic] health maintenance organization (HMO)."

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In this case, we must consider applicant's services to encompass at last some of the services identified in the cited registrations. Applicant argues that its services

are business services, and are therefore not in conflict with the registrants' medical services. However, we must base our determination of the issue of likelihood of confusion on the identification of services set forth in the application and in the cited registrations. **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976); see also, **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) ("it is well settled in a proceeding such as this, the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be.") As noted previously, applicant has identified its services broadly as "arranging for providing health care services, namely, dental services, vision services, chiropractic, acupuncture, massage therapy, hearing services and non-medical elderly home care." Arranging for providing health care services would encompass managed health care services. Although applicant has explained that its services are different from those provided by a health maintenance organization or preferred

provider organization, its identification is not so limited.

This brings us to a consideration of the marks. When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, the marks are extremely similar. In pronunciation they are virtually identical, HEALTHLYNX differing from the HEALTH LINK registrations only in being in the plural form. In appearance the marks are also very similar. Each of the marks begins with the word HEALTH, and although applicant's mark uses a variant spelling of LINK, this is not likely to be noted or remembered. Similarly, although one of the registrations is in stylized form, the typestyle is not so distinctive that this would serve to distinguish the marks. Moreover, applicant has applied for registration of its mark as a typed drawing, and if a registration were to issue to applicant, it would confer protection on applicant's use of the same stylized font. As for the heart design in the registration owned by HealthLink, Inc., again, this design does not serve to distinguish the marks. In evaluating the similarities of marks, a particular

feature or portion of a mark can be accorded greater weight if it would make an impression upon purchasers that would be remembered and relied upon to identify the goods or services. If one of the marks comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). Because consumers might well recommend or refer to managed health care services or the service of arranging for providing health care services by word of mouth, the slight differences in appearance between applicant's mark and the cited marks are insufficient to distinguish the marks.

We note that LINKS has been misspelled in applicant's mark with the result that the term is spelled the same as the animal. However, there is no indication that consumers would ascribe such a connotation to the mark and, indeed, applicant does not make such a claim. Applicant asserts only that the "X" in its mark references the plural of LINK, and suggests that applicant provides more than one service, i.e., dental, vision, chiropractic and so on.

We do not think that the misspelling, or the pluralization, distinguishes the marks in terms of connotation. Because the identifications in the cited



registrations are for health management organizations and preferred provider organizations, and a variety of medical services are provided through such organizations, consumers are not likely to note or understand there is a difference in connotation between applicant's mark and the cited marks.

Although we recognize that there are slight differences between applicant's mark and the cited marks which can be detected when they are placed side by side, under actual marketing conditions consumers do not have the luxury to make side-by-side comparisons between marks, and instead they must rely on hazy past recollections. **Dassler KB v. Roller Derby Skate Corp.**, 206 USPQ 255 (TTAB 1980). It is not clear to us that under such conditions consumers would even notice the differences between the marks; however, even if these differences were noticed, consumers are likely to believe that applicant's mark is a variation of the cited marks, and not that applicant's mark identifies a separate source for the service of arranging for providing health care services.

Applicant also points to the fact that the term HEALTH has been disclaimed in two of the cited registrations (it was not disclaimed in Registration No. 2,058,527 because it appears as part of a single word, HEALTHLINK and, under

Office practice, no disclaimer is required in such a situation; we assume that, for similar reasons, applicant was not required to disclaim this word). Certainly the word HEALTH is descriptive of health care services, and if this were the only common element we would agree with applicant that this would not be sufficient to find confusion likely. However, the involved marks are HEALTHLINK/HEALTHLYNX and, as discussed above, the slight differences between applicant's mark and the cited marks are not sufficient to distinguish them. Even if we consider the scope of protection of the mark HEALTH LINK or its variations to be limited, it still extends to prevent the registration of HEALTHLYNX for services which are, in part, legally identical.

We would also point out that the scope of protection of the cited marks should not be deemed to be limited because the registrations are owned by two different entities. The fact that the Office allowed the North Mississippi Health Services, Inc. registrations despite the existence of the HealthLink, Inc. registration does not mean that the Office viewed the HEALTHLINK and heart design mark to be entitled to a limited scope of protection, or that the Office believes that the three HEALTH LINK marks can coexist without confusion. As the Examining Attorney

has noted, and as is noted on the cited registrations, the two registrations owned by North Mississippi Health Services, Inc. were published subject to a concurrent use proceeding with the registration owned by HealthLink, Inc. This shows that the Office found that the marks were likely to cause confusion, and the two later applications by North Mississippi Health Services, Inc. were approved for publication only on condition that they would be geographically limited so as to prevent confusion.

Decision: The refusal on the ground of likelihood of confusion and the requirement for an acceptable identification of services are affirmed; the requirements for acceptable specimens and for information as to the nature of the services are reversed.